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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,341	03/29/2004	Thomas J. Perkowski	100-062USA000	9991
7590 01/10/2008 Thomas J. Perkowski, Esq. Thomas J. Perkowski, Esq., P.C. Soundview Plaza 1266 East Main Street Stamford, CT 06902			EXAMINER CARLSON, JEFFREY D	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 01/10/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/812,341	Applicant(s) PERKOWSKI ET AL.	
	Examiner Jeffrey D. Carlson	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/07/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the paper(s) filed 10/4/04.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 1, 2, 4-8, 10, 17, its is not clear whether A/B/C/D requires any one of A, B, C or D – or requires all of them.
- Claim 11 is a system (apparatus) claims, yet it include many features which are presented as method steps rather than capabilities, rendering the claim scope uncertain. In these computer-based system claims, the best way to set forth apparatus structure is to claim *capabilities* of the apparatus by stating an element/module/subsystem is *programmed to <perform an act>* OR is *configured to <perform an act>*, rather than claiming the element actively performs the act. A claim covering both an apparatus and a method of using that apparatus is invalid because such a claim “is not sufficiently precise to provide competitors with an accurate determination of the ‘metes and bounds’ of protection involved” and is “ambiguous.” MPEP 2173.05(p)(ii).
- Claims 19-22, there is no antecedent basis for the third subsystem.

- Claim 24, it is unclear how an HTML document can be an image. It could include an image perhaps, but it apparently cannot *be* an image.
- Claim 28, it is unclear what *structure* of the system is being set forth. The parties using an apparatus/system do not define the elements of the apparatus/system.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern (US6591247) in view of Durst, Jr. et al (US6542933).

Regarding claims 1, 2, 4-8, 10-30, Stern teaches systems and methods for providing networked, in-store kiosks that can be used to deliver product information and advertisements. A centralized server (NMC/NOC 12/20) receives various types of content (ads, information, audio, video, etc) and makes the content available to various stores [fig 1]. Each store has plural kiosk sites 30 including a video screen, keyboard and light pen. The kiosks and servers are connected by way of IP protocol and/or the Internet [4:46-68]. A consumer can scan the UPC barcode of a product at the kiosk and receive advertising and information about the product [6:46-50, 7:14-17, 27-32, 48-50]

which provides a positive brand experience. Applicant claims database storage of “UPN/TM/PD/URL links” and provides language describing what each acronym stands for, yet no structure is positively claimed other than “links”. Stern teaches that the central database provides a UPC-indexed database of products that stores the relationship (via the tblUPCmaster table) between the UPC codes and the associated content (ads, information, audio, etc) associated with that product [8:10-25]. It would have been obvious to one of ordinary skill at the time of the invention to have indexed the products by any key including UPN, TM, or PD as done by applicant. The UPC codes of Stern are taken to be equivalent to applicant's in that they both provide an item identifier to be used for database lookups to retrieve and deliver advertising and item information. Regarding the first subsystem, Stern teaches that functionality is provided to input ads/information into the system [6:1-34] which is taken to represent programming of the various information modes. The display of ads and information to the requesting user about the requested item is taken to provide a virtual kiosk that displays advertisements and information which are taken to promote the item. Stern does not teach a servlet and triggering HTML tag. Durst, Jr. et al also teaches a means for a consumer to scan a barcode (at a kiosk [8:1-3]) in order send a request to a centralized server for more information about the item scanned. Durst, Jr. et al teaches that the item identification/barcode is scanned into the a web browser and sent to the server. The server determines where the information file(s) are stored and either redirects/links the user to the URL of such information, or the server retrieves the information and delivers it to the requesting user's web browser [3:15-30, 66-67].

Although any advertisement content delivered through an advertising mode is taken to promote the item advertised, therefore providing a promotion and promotion mode, Durst, Jr. et al teaches product descriptions as well as product promotions [col 23 lines 7-29]. It would have been obvious to one of ordinary skill at the time of the invention to have provided a mode for displaying product promotions as well Stern's displaying advertising mode and product information mode in order to provide more brand awareness and encourage the consumer to purchase a particular brand. The display of the links of Stern is taken to provide a subsystem which provides for a URL link display mode. Durst, Jr. et al also teaches that because the barcode or other entered identifier does not include the URL of the content, that the server may provide the mapping between the UPC/USN/item identifier and the location of the content by way of a JAVA servlet [6:37-60]. It would have been obvious to one of ordinary skill at the time of the invention to have provided such a web-based item request and server delivery mechanism for providing advertising and information about the requested products. Any object in the submission web page (i.e. the well known submit button on a form such as in Durst, Jr. et al FIG 14) is taken to be an HTML tag which triggers the request for ads/information. Any web page displaying any content about the requested item is taken to be a "virtual kiosk." Stern teaches providing ads, audio, video and information about the item. Durst, Jr. et al teaches providing product and other types of information about products. It would have been obvious to one of ordinary skill at the time of the invention to have returned a list of URL links to the user when the product requested is

associated with plural content files (ads, promotions, information, warranty, etc), so that the user may choose which content to review.

Regarding claim 3, the systems of Stern and Durst, Jr. et al are taken to at least represent online item catalogs.

Regarding claim 9, Durst, Jr. et al teaches that plural servers may be provided to carry out the invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc